

REMARKS:

This paper is filed in response to the above captioned Requirement for Restriction/Election, along with a petition for an extension of time of five (5) months under 37 CFR 1.17(a)(5) and the authorization for the Office to deduct the requisite fees for such petition and fees associated with the this response. Therefore, it is believed that this paper is timely filed.

Proper Claims Set Not Evaluated by Examiner

It is believed that the Examiner should have based the action for restriction/election on the amended set of claims filed within the three month period after the ISR was mailed February 16, 2006. The Amended set of claims was submitted on May 16, 2006 to the International Receiving Office directed to the Examiner in this case. It is believed that the restriction requirement based on the originally filed set of claims in the PCT is thus in error and the Examiner should reconsider the restriction requirement based on the proper set of claims pending in the PCT application at the time the application entered the national stage in the US. The amended set of claims is submitted herewith as an appendage to this response and consists of 8 pages, each page marked at its top with the characters:

PCT/US04/41723.16052006

...US 16/05/06

IPEA/US

In which the date stamp "US 16/05/06", refers to May 16, 2006, the date upon which the documents were received by the US Receiving Office.

This submission of amended claims entered into the PCT file wrapper contained 24 claims in contrast to the 32 originally filed claims. Thus, it is believed that the 24 claims in the claims set forth above, as further amended herewith, correspond to the correct set of claims that are believed to be pending in this application, in contrast to the 32 claims in the claims set upon which the Examiner has based the restriction requirement.

Nevertheless, in order to be perceived as being fully compliant with the requirements of the Restriction/Election Requirement, the Applicant is provisionally electing Group II, claims 5, 8, 10-20, 26, and 31-32, [of the originally filed claims] drawn to a transformed maize plant, subcombination thereof, and methods of using, and as indicated below, traverses the restriction requirement.

Claims Amendments

The claims amendments introduced above are believed to be fully supported by the specification as filed and do not introduce new matter. The amendments introduced above to the pending 24 claims are based on the set of claims as filed under Art. 34 PCT and the claims as originally filed (hereinafter the "Article 34 claims" and "original claims", respectively) as follows:

Claim 1 is based on Article 34 claim 1, wherein the DNA molecule has been further specified as being "isolated from corn event MON88017" based on para. 11 on p. 4 of the specification and the complementary DNA sequence has been specified as "completely complementary" based on para. 48, on page 15, lines 14-18 of the specification.

Claims 2 and 3 correspond to Article 34 claims 2 and 3, respectively, wherein the feature "complement" has been specified as "complete complement" in a similar manner as in claim 1, also the lower limit of the contiguous nucleotides has been limited to "at least 16 contiguous nucleotides" (based on para. 15 on p. 5, lines 18-20 of the specification).

Claims 4 and 5 are identical with Article 34 claims 4 and 5, respectively.

Claim 6 is based on Article 34 claim 6, wherein the primers have been specified as first and second primers based in original claim 6.

Claim 7 is based on Article 34 claim 7, wherein the feature "complementary" has been specified as "completely complementary" as in claim 1.

Claim 8 is based on Article 34 claim 8 which has been specified that it is the zygoty of "the genome" DNA of a corn plant that is determined (based on para. 52 on page 17-18 of the specification).

Claims 9-14 are identical with Article 34 claims 9-14.

Claims 15 and 16 are based on Article 34 claims 15 and 16, wherein the lower limit of the contiguous nucleotides has been specified in a similar manner as in claims 2 and 3.

Claim 17 is based on Article 34 claim 17, wherein the feature "complementary" has been specified as "completely complementary" in a similar manner as in claim 1.

Claim 18 is based on Article 34 claim 18, wherein the nucleotide sequence has been specified as being "derived from DNA in the genome of corn event MON88017", referenced at least at paragraph 52 bridging pages 17 and 18 of the international publication WO2005/059103, particularly at the first five or six lines of page 18 and thereafter.

Claim 19 is based on Article 34 claim 19, wherein the lower limit of the contiguous nucleotides has been specified in a similar manner as in claims 2 and 3.

Claims 20 and 21 correspond to Article 34 claims 20 and 21 which have been adapted to the new wording of claim 19.

Claim 22 corresponds to Article 34 claim 22 which has been adapted to the wording of the preceding claims.

Claim 23 is identical with Article 34 claim 23.

Claim 24 is based on Article 34 claim 24 which has been amended to increase intelligibility and by specifying the detectable sample.

It is respectfully requested that the Examiner find that the Article 34 claims corresponds to the claims set upon which the Examiner should have based the notice of restriction/election requirement, and enter these claims into the record.

The Restriction/Election Requirement

The Examiner asserts that the inventions or groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1, and further indicates that the three groups of inventions do not relate to a single general inventive concept under PCT Rule 13.1 because, under Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the invention of Group I, claim 1, was known in the prior art at the time of the invention. Windels et al (2001) disclose a fragment of instant SEQ ID NO:5 that is useful as a DNA primer molecule at Table 1 on page 109 (the non 1 NEST primer), hence the claims do not relate to a single general inventive concept because they lack the same special technical features. The Applicant traverses the restriction requirement.

The inventions are so linked based on the requirement for the detection or the presence of the sequence as set forth in SEQ ID NO:1 and/or SEQ ID NO:2 (or significant parts or complete complements thereof) when detected in or present in corn genomic DNA corresponding to corn event MON88017 as to form a single genomic DNA. In other words the special technical feature linking the different aspects of the application are the presence of the sequences of SEQ ID NOs: 1 and/or 2 (or at least 16 contiguous nucleotides thereof or complete complements thereof) in the sequences to be detected or the presence in or its use to detect the presence of these particular nucleotides, which detection is thus diagnostic for the presence of the corn event MON88017. The feature "at least 16 contiguous nucleotides" of SEQ ID NOs: 1 and 2 is novel over the art or is detected in or present in corn genomic DNA corresponding to corn event MON88017, and represents the linking technical feature. Thus, because the claims all unite under this special technical feature, it is believed that the claims all correspond to a single general inventive concept and should all be examined together, which would not result in a serious search and examination burden, searching for the presence of the two sequences SEQ ID NO 1 and 2 in corn genomic DNA. The fact that Windels et al has cited a 20 nucleotide sequence corresponding to a segment of an element referred to as "NOS 3' DNA" within the inserted DNA of the corn event MON88017 is not claimed, and the binding of the Windels et al nucleotide sequence to the corn genome of corn event MON88017 is not then within the scope of the claims because the binding of the particular Windels DNA is not diagnostic for the presence of corn event MON88017 DNA in a biological sample. In fact, it is likely that the cited Windels et al primer would bind to dozens of transgenic plants available commercially because many of these other transgenic events utilize the NOS3' transcription termination and polyadenylation signal in the expression cassettes inserted into the respective plant genomes. However, the binding of the cited Windels et al primer would not then be diagnostic for the presence of corn event MON88017 DNA in a particular biological sample. Only the detection of the sequence set forth at SEQ ID NO 1 or 2 or the complements thereof in corn event MON88017 genomic DNA is diagnostic for the presence of this particular event DNA in any particular biological sample containing corn genomic DNA. For these reasons, the special technical feature that binds all of the claims together are the two short segments of DNA referred to as SEQ ID NO:1 and SEQ ID NO:2, or longer segments such as amplicons produced from any particular biological sample containing corn DNA using various primers directed to amplification of the segments

of DNA from the corn event MON88017 genome that would then contain these two short segments, the detection of which would then be diagnostic for the presence of the corn event MON88017 in such sample. Thus it is believed that all of the claims are united in inventive concept due to this particular special technical feature and should then all be examined together.

In the event that the Examiner persists in maintaining the restriction requirement, the Applicant specifically reserves its right to appeal the decision, and specifically requests rejoinder of the claims not elected to the extent that such claims related to the subject matter of the elected claims at the time subject matter is determined to be allowed or allowable.

It is respectfully requested that the Examiner enter the above referenced claims set forth above and act upon these claims in view of the restriction requirement and the remarks set forth above and find that all the claims meet the unity of invention requirements under PCT Rule 13.1 and 13.2, that the claims should all be examined together, and find that the claims are now in condition for allowance.

It is therefore believed that the Applicant has fully complied with the requirement to reply to the Restriction/Election requirement. It is respectfully requested that the Office enter the documents provided herewith into the record and submit the application to substantive examination at the earliest opportunity.

Respectfully submitted,

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Date: _____

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